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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,924	11/10/1999	TAKASHI HIROSE	P/2371-27	8642
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Steven I. Weisburd, Esq.			EXAMINER	
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1177 Avenue of the Americas			ART UNIT	PAPER NUMBER
41st Floor				2135
New York, NY 10036-2714				DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/437,924	HIROSE, TAKASHI
Examiner	Art Unit	
Allen S. Wu	2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 04 November 2003.

2a)  This action is **FINAL**.                            2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## **Disposition of Claims**

4)  Claim(s) 1-4,6-9 and 12 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-4,6-9 and 12 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 10 November 1999 is/are: a)  accepted or b)  objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.  
13)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a)  The translation of the foreign language provisional application has been received.  
14)  Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.  
4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 4 and 6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanjo, Japan Patent JP406119363A, in view of Tabata et al, Japan Patent JP10143414A, and further in view of Smithies, US Patent 5,818,955.

In regards to claim 1, Nanjo discloses an electronic document management system comprising: a document storage unit for storing electronic documents, a signature image storage unit for storing and supplying the attest information upon request (admission of prior art pages 1 and 2). Nanjo does not explicitly teach the use of a computer network with a plurality of computer

systems for supplying the electronic documents. It is to be inherent to the invention of Nanjo to use computer systems in a network to supply the electronic document with a signature image. An electronic document needs to be generated by some means and sent to the document storage unit by another means.

Nanjo teaches storing identification information on the data storage system (recognition information, page 7 of translation) and attest data storage system (recognition number, see translation page 8). Nanjo does not explicitly teach the storing of ID number of document data storage system in the attest storage system. Tabata et al discloses storing an ID of the document data storage system (Document database name, see translation page 36) and document ID (document number, see translation page 36). One of ordinary skill in the art at the time of the applicant's invention would have realized the storing the addition of an ID of the data storage system and document ID to the identification information in the attest data storage system of Nanjo. Furthermore, one of ordinary skill in the art at the time of the applicant's invention would have been able to store the document number in addition to the identification information on the data storage system of Nanjo's teachings. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Nanjo within the system of Tabata et al because of the added efficiency by allowing the system to know which data storage system to search for the document. Furthermore, Nanjo does

not teach the use of barcodes to store management data. Tabata et al. discloses a document storage medium for storing electronic documents with a three-dimensional bar code for document management information (Abstract and page 34 paragraph 42). One of ordinary skill in the art at the time of the applicant's invention would have been able to adopt barcodes for storing identification information. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Tabata et al. within the system of Nanjo because of added efficiency to the system. Barcodes are well known in the art to be able to encode large amounts of information into a small area.

Furthermore, the combination of Nanjo and Tabata et al does not explicitly teach the data storage system storing ID number of the attest data storage system. Smithies et al discloses storing of attest storage system ID number (col 11 In 59-67). One of ordinary skill in the art at the time of the applicant's invention would have realized the ID number of the attest data storage system as additional identification information that can be stored in the data storage system of the combination of Nanjo and Tabata et al. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Smithies et al within the combination of Nanjo and Tabata et al because it would have increased security through the additional identification information.

In regards to claim 4, Nanjo discloses an electronic document management system comprising: a document storage unit for storing electronic documents, a signature image storage unit for storing and supplying the attest information upon request (admission of prior art pages 1 and 2), the signature image being used as approval of the electronic document by a signer (recognition information...recognition person, translation page 6) and storing the electronic document in association with one attest data in the document storage system (translation page 8). Nanjo further teaches an attest data storage system for storing attest data (recognition image-data memory, see translation page 7 and admitted prior art page 1 and 2) and supplying said attest data to said document data storage system upon request and/or approval by the signer (synthetic output means, see translation page 8).

Nanjo teaches storing identification information on the data storage system (recognition information, page 7 of translation) and attest data storage system (recognition number, see translation page 8). Nanjo does not explicitly teach the storing of ID number of document data storage system in the attest storage system. Tabata et al discloses storing an ID of the document data storage system (Document database name, see translation page 36) and document ID (document number, see translation page 36). One of ordinary skill in the art at the time of the applicant's invention would have realized the storing the addition of an ID of the data storage system and document ID to the identification information in the attest data storage system of Nanjo. It would

have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Tabata et al within the system of Nanjo because of the added efficiency by allowing the system to know which data storage system to search for the document. Furthermore, Nanjo does not teach the use of barcodes to store management data. Tabata et al. discloses a document storage medium for storing electronic documents with a three-dimensional bar code for document management information (Abstract and page 34 paragraph 42). One of ordinary skill in the art at the time of the applicant's invention would have been able to adopt barcodes for storing identification information. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Tabata et al. within the system of Nanjo because of added efficiency to the system. Barcodes are well known in the art to be able to encode large amounts of information into a small area.

Furthermore, the combination of Nanjo and Tabata et al does not explicitly teach the data storage system storing ID number of the attest data storage system. Smithies et al discloses storing of attest storage system ID number (col 11 ln 59-67). One of ordinary skill in the art at the time of the applicant's invention would have realized the ID number of the attest data storage system as additional identification information that can be stored in the data storage system of the combination of Nanjo and Tabata et al. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the

teachings of Smithies et al within the combination of Nanjo and Tabata et al because it would have increased security through the additional identification information.

In regards to claim 6, Nanjo further discloses a document data storage system receiving a signature image from an attest data storage system upon approval by the signer (recognition person will check...recognition information, see translation page 8).

In regards to claim 7, Nanjo further discloses the document storage system request said attest data storage system to deliver said attest information based on the signer ID (admitted prior art page 2).

In regards to claim 8, Nanjo further discloses a document storage system and an attest storage system storing said electronic document in association with an ID number of the signer (correspond to recognition person number, see translation page 7; recognition information see translation page 8 and prior art page 2). Furthermore, the combination of Nanjo and Tabata et al does not explicitly teach the data storage system storing ID number of the attest data storage system association with the electronic document. Smithies et al discloses storing of attest storage system ID number (col 11 ln 59-67). One of ordinary skill in the art at the time of the applicant's invention would have realized

the ID number of the attest data storage system as additional identification information that can be stored in the data storage system of the combination of Nanjo and Tabata et al. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Smithies et al within the combination of Nanjo and Tabata et al because it would have increased security through the additional identification information.

Nanjo does not explicitly teach the storing of ID number of document data storage system in the attest storage system. Tabata et al discloses storing an ID of the document data storage system in regards to the document (Document database name, see translation page 36). One of ordinary skill in the art at the time of the applicant's invention would have realized the storing the addition of an ID of the data storage system and document ID to the identification information in the attest data storage system of Nanjo. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Tabata et al within the system of Nanjo because of the added efficiency by allowing the system to know which data storage system to search for the document.

3. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanjo, Japan Patent JP406119363A, in view of Tabata et al, Japan Patent JP10143414A, further in view of Smithies, US Patent 5,818,955, as applied to claim 1 above, and further in view of Khan et al, US Patent 6,401,206.

In regards to claim 2, Nanjo discloses the storage of authentication information including the ID number of the signer (recognition person number, see translation page 8). However, Nanjo does not teach the use of barcodes to store management data. Tabata et al. discloses a document storage medium for storing electronic documents with a three-dimensional bar code for document management information (Abstract and page 34 paragraph 42). One of ordinary skill in the art at the time of the applicant's invention would have been able to adopt barcodes for storing identification information. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Tabata et al. within the system of Nanjo because of added efficiency to the system. Barcodes are well known in the art to be able to encode large amounts of information into a small area.

Furthermore, the combination of Nanjo, Tabata et al, and Smithies et al does not teach the storage of the serial usage number by the signer. Khan et al discloses storage of a serial usage number (col 11 ln 22-50) for verification purposes. One of ordinary skill in the art at the time of the applicant's invention would have realized the addition of a serial usage number to the authentication of information already being stored by the teachings of Nanjo. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to include the serial usage number as extra authentication data because of the added security due to the extra information used for authentication.

In regards to claim 3, Nanjo discloses the attachment of signature images to an electronic document (translation page 8). However, the combination of Nanjo, Tabata et al, and Smithies et al does not teach the attachment of a plurality of signature images to an electronic document. Khan et al discloses appending a plurality of signature images to a document (multiple impressions, col 13 ln 51-56). One of ordinary skill in the art would have realized repeating the attaching step of Nanjo to bind multiple signature images. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Khan et al within the combination of Nanjo, Tabata et al, and Smithies et al because it would have increased security to documents with multiple signers by having all the signature images on the document to be authenticated.

4. Claims 9 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nanjo, Japan Patent JP406119363A, in view of Tabata et al, Japan Patent JP10143414A, further in view of Smithies, US Patent 5,818,955, and further in view of Siy, US Patent 4,286,255.

As per claim 9, Nanjo discloses an electronic management system comprising: registering a signature image data in association with a signer ID number (sign of a recognition person as image data, see translation page 7) temporarily storing primary document data including an electronic document

(document is completed, see translation page 7) in association with a signer ID number (recognition person number (see translation page 8). Nanjo further discloses transferring the registered signature image data based on the signer ID number in the primary document data (extract the recognition image data see translation page 8) and attaching the registered signature image data to the primary document data to complete a secondary document data (compound document data and its recognition image, see translation page 8 and 10) to be stored (see translation page 10 paragraph 10).

Nanjo further discloses storing recognition information in association with the registered image data. However, Nanjo does not explicitly teach storing a system ID number of a system storing said secondary document data. Tabata et al discloses storing the system ID of a system storing document data (document database name, see translation page 36). One of ordinary skill in the art at the time of the applicant's invention would have realized storing the addition of an ID of the data storage system in association with the registered signature image data. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Tabata et al within the system of Nanjo because of the added efficiency by allowing the system to know which data storage system to search for the document.

Furthermore, Nanjo discloses attaching signature image data. The combination of Nanjo and Tabata et al does not explicitly teach attaching a system ID number of a system registering said signature image data. Smithies et

al discloses storing of attest storage system ID number (col 11 ln 59-67). One of ordinary skill in the art at the time of the applicant's invention would have realized the ID number of the attest data storage system as additional identification information that can be stored in the data storage system of the teachings of Nanjo. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Smithies et al within the combination of Nanjo and Tabata et al because it would have increased security through the additional identification information.

Furthermore, Nanjo discloses temporarily storing of document data (document is completed, see translation page 7). However, the combination of Nanjo, Tabata et al and Smithies et al do not teach the document data including an electronic document having therein a signature image. Siy discloses temporarily storing of document data including an electronic document having therein a signature image for verification purposes (scanning a document containing...signature, abstract and col 2 ln 20-37). One of ordinary skill in the art at the time of the applicant's invention would have been able to modify the document data of Nanjo's system to include an electronic document having therein a signature image. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to combine the teachings of Siy within the combination of Nanjo, Tabata et al, and Smithies because it would have added convenience by allowing a user to apply the signature off line and not at time of verification.

In regards to claim 12, Nanjo discloses approval by a signature signing the signature image in the electronic document before transferring the registered image data (check the content of the document, see translation page 8).

***Response to Arguments***

5. Upon request of the applicant, the examiner has initialed copies of the PTO-1449 forms and copies of initial PTO-1449 forms are included in this correspondence.
6. Examiner agrees with incompletely acknowledging the filing of certified copy of the priority document in the application. New acknowledgment has been stated above.
7. Applicant's arguments, see page 9 paragraph 4, filed November 4, 2003, with respect to fig 2 have been fully considered and are persuasive. The objection of fig 2 has been withdrawn.
8. Applicant's arguments, see page 9 paragraph 5, filed November 4, 2003, with respect to the specification have been fully considered and are persuasive. The objection of the specification has been withdrawn.
9. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the efficiency of systems through the use of barcodes is well known in the art.

10. Applicant's arguments with respect to claim 9 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Wong et al, US Patent 6,557,102, discloses an image management system.

Zimmerman et al, US Patent 6,484,933 discloses encoding identification information into barcodes.

Zhao et al discloses authentication of documents using bar codes.

Wang et al discloses a method of authenticating and managing documents.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Allen S. Wu whose telephone number is 703-305-0708. The examiner can normally be reached on Monday-Friday 9am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 703-305-4393. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-0900.

Allen S. Wu  
Examiner  
Art Unit 2135

ASW



KIM VU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100